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EXAMINER

PAULA, CESAR B

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/034,255
Filing Date: January 03, 2002
Appellant(s): EISEN, JEFFREY N.

Syed Jafar Ali
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/14/2006 appealing from the Office action mailed 5/18/2006.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

There were no amendments after final, only a request for reconsideration.

(5) *Summary of Claimed Subject Matter*

The summary of the claimed invention in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The grounds of rejection contained in the brief are correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

USPub.# 2003/0097361, Huang (5/22/2003, filed on 6/15/1999).

Barnes, "10 Minute Guide to Windows 3.1", Alpha, 1992, pp.60-65.

Outlook 2000 sp-3, copy and paste screendumps & Outlook 97 editing screendumps,
Microsoft Corp., (1996, 1999).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Appellant regards as his invention.

2. Claims 1-25 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Claim 23 still recites "the list can be" (line 15). The cited language introduces ambiguity into the claims, since it implies that the step may or may not be carried out.

3. Claims 1, 8, 15, and 24 recite "the list is able" (lines 14, 14, 17, and 12 respectively). The cited language introduces ambiguity into the claims, since it implies that the step may or may not be performed. It shows that the potential of performing the step is there, but is not necessarily realized.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (USPub.# 2003/0097361, 5/22/2003, filed on 6/15/1999), in view of Barnes, Kate, hereinafter Barnes, "10 Minute Guide to Windows 3.1", Sams, 1992, p. 60-65, and further in view of Outlook 2000 sp-3, copy and paste screendumps & Outlook 97 editing screendumps (1996), Microsoft Corp., hereinafter Outlook, 1999.

Regarding independent claim 1, Huang discloses displaying to a user a list of received email messages, containing descriptive information—*summary data regarding the email associated with the information, in a window 320. The user views the email messages by clicking on one of the message information—summary view of one or more entries to a user, wherein each of the one or more entries is associated with a document; enabling a user to select one or more of the entries listed in the summary view--* (0060, and fig. 3B). Huang fails to explicitly disclose: *receiving input from the user to create a reusable list of the selected entries and to store the list in a system clipboard in response to the input received from the user.*

However, Outlook teaches the creation of a list by creating a copy of selected email document entries-- *create a reusable list of the selected entries--* using computer commands (pages 1, and 3). Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, Outlook, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Moreover, Huang discloses displaying to a user a list of received email messages, containing descriptive information—*for each of the one or more selected document entries, the reusable list includes document summary data pertaining to the document associated with the selected entry*, in a window 320. The user views the email messages themselves by clicking on one of the message information—*hyperlink to the document associated with the selected entry, not a copy of the document* -- (0060, and fig. 3B). Huang fails to explicitly disclose: *the list is able to be pasted into one or more documents or transferred to one or more programs in addition to the program displaying the summary view*. Outlook teaches the creation of a list by creating a copy of selected email document entries, and pasting this copy to a word application document-- *create a reusable list of the selected entries*-- using computer commands (pages 1, and 3)-- *the list can be pasted into one or more documents or transferred to one or more programs*. Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, Outlook, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Furthermore, Huang fails to explicitly disclose: *in response to the user selecting a hyperlink from the reusable lists displaying a current version of a document associated with the hyperlink including any changes made to the document subsequent to creating the reusable list*. Outlook teaches the display of an updated email document whenever an email is clicked on, the latest version of that email is displayed to the user (fig. 1-5, Outlook 97). It would have been

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obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, Outlook, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Regarding claim 2, which depends on claim 1, Huang discloses the display of the selected files along with an email recipient's information, accessing the email by selecting the hyperlink of file email entry—*document summary data*-- (0060, and fig. 3B).

Regarding claim 3, which depends on claim 1, Huang discloses the display of the selected files along with an email recipient's information, accessing the email by selecting the hyperlink of file email entry (0060, and fig. 3B).

Regarding claim 4, which depends on claim 1 Huang discloses the display of the selected files along with an email recipient's information, accessing the email by selecting the hyperlink of file email entry— (0060, and fig. 3B). Huang fails to explicitly disclose: *documents that are found by an Internet search engine*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used documents in a discussion thread, because Huang teaches quickly and conveniently accessing links to news, and information over the Internet (0162-0163). This provides the benefit of making it quicker, and easier for a user to retrieve email documents posted on an Internet bulletin board.

Regarding claim 5, which depends on claim 1, Huang discloses the display of the selected files along with an email recipient's information, accessing the email by selecting the hyperlink of file email entry— (0060, and fig. 3B). Huang fails to explicitly disclose: *documents that are found in a discussion thread*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have used documents in a discussion thread, because Huang teaches quickly and conveniently accessing links to news, and information over the Internet (0162-0163). This provides the benefit of making it quicker, and easier for a user of a bulletin board to access, and manipulate email messages included in a thread.

Regarding claim 6, which depends on claim 1, Huang discloses the selection of files displayed on the screen checking a checkbox associated with each of the displayed files (0084-0085, and fig. 7A).

Regarding claim 7, which depends on claim 1, Huang discloses displaying to a user a list of received email messages, containing descriptive information—*summary data regarding the email associated with the information*, in a window 320. The user views the email messages by clicking on one of the message information (0060, and fig. 3B). Huang fails to explicitly disclose: *inserting, and storing the table in a system clipboard*. However, Outlook teaches the creation of a list by creating copying rows of selected email document entries-- *create a reusable list of the selected entries*-- using computer commands (pages1, and 3). Barnes teaches the copying of information using Windows system clipboard (page 60, lines 4-9, 15-19, fig.10.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to

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have combined Huang, Outlook, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

Claims 8-14 are directed towards a computer system for implementing the steps found in claims 1-7 respectively, and therefore are similarly rejected.

Claims 15-21 are directed towards a computer readable medium for storing the steps found in claims 1-7 respectively, and therefore are similarly rejected.

Claim 22 is directed towards a computer signal embodied in a computing system for implementing the steps found in claim 1, and therefore is similarly rejected.

Claim 23 is directed towards a method equivalent to the steps found in claim 1, and therefore is similarly rejected.

Claim 24 is directed towards a method equivalent to the steps found in claim 1, except for *the summary information including at least one of an author associated with the document or a date associated with the document or a subject associated with the document*, which is taught by Huang's display to a user of a list of received email messages, containing descriptive

information, such as a sender of the email -- *an author associated with the document* (0060, and fig. 3B), and therefore is similarly rejected.

Regarding claim 25, which depends on claim 24, Huang's teaches the display to a user of a list of received email messages, containing descriptive information, such as the subject of the email -- *a filename of the associated document* (0060, and fig. 3B)

(10) Response to Argument

Regarding claims 1, 8, 15, 23, and 24, the Appellant states that the 35 USC 112, 2nd parag. rejection based on the "list is able", and the list can be", is improper (page 8). The Examiner disagrees, because the scope of the claims is rendered vague by the language cited above. The fact that a list might be able to do many things, is not indicative that these limitations are part of the metes and bound of the claim language. For instance, this language is akin to the alternative phraseology used in claim recitations, where one of many items (not all of them) only need be present in the prior art in order to meet the claim limitation. Similarly, one could argue that most if not all document lists are able to be pasted into documents. As shown in Outlook, and Barnes copy and paste functionality was widely know in the art at the time of the invention. However, this does not mean that these lists are pasted to other documents just because they can. The owner of these lists might intend for them to perform functionalities other than that of copy and paste. Again, ability does not necessarily translate into functionality. Therefore, the claim language is not clear and unambiguous as to what's being done in the claim.

Regarding claims 1-25, the Appellant alleges that there is no motivation to combine Huang, Barnes, and Outlook (pages 9-10). The Examiner disagrees, because although Huang fails to explicitly disclose: *in response to the user selecting a hyperlink from the reusable lists displaying a current version of a document associated with the hyperlink including any changes made to the document subsequent to creating the reusable list*, Outlook teaches the display of an updated email document whenever an email is clicked on; the latest version of that email is displayed to the user (fig.1-5, Outlook 97). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Huang, Outlook, and Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files. In other words, the user has the benefit of quickly accessing the email messages associated with the hyperlinks without having to directly modify the messages by copying them into the system clipboard, and then into the word processing document (word document with inserted links to the messages, page 3). Thus, preserving the data in the original email messages, and displaying whatever data is present therein by the selection of the link(s) inserted into the word processing document, including any changes made to the messages after the links have been copied to the word processing document.

Moreover, the Appellant notes that neither Huang, Barnes, nor Outlook teach *creating a reusable list of the selected entries and to store the list in a system clipboard* (pages 11-12). The Examiner disagrees, Huang fails to explicitly disclose: *receiving input from the user to create a*

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reusable list of the selected entries and to store the list in a system clipboard in response to the input received from the user. However, Outlook teaches the creation of a list by creating a copy of selected email document entries-- *create a reusable list of the selected entries*-- using computer commands (pages 1, and 3). Barnes teaches the copying or storing of information using Windows system clipboard (page 60, lines 4-9, 15-19). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the list of email messages of Huang, the copying and pasting of the list of email messages as hyperlinked information-- a reusable list-- of Outlook, and the use of a system clipboard to copy and paste textual, and graphical information found in Barnes, because Barnes teaches above copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files attached to the email, utilizing the copying process, so that the user is able to use those files without loss or damaging these files.

The hyperlinked list of email information taught by Outlook (page 3) is made up data having both textual description, and graphical icons. Barnes teaches the storage of both textual and graphical data, such as the type found in Outlook, and Huang. It would have been obvious to one of ordinary skill in the art to combine Huang, Barnes, and Outlook for all the reasons indicated above.

The Appellant argues that "the Examiner has provided several screenshots of an Outlook Inbox, but has not provided any screenshots to show "pasting [the] copy [of the Outlook Inbox] to a word application document," as

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alleged” (page 12, parag.3). The Examiner disagrees, because the screendumps of Outlook found on pages 1-3 (mailed on 5/18/06), show exactly the pasting of email entries to a word document. The pasting takes place through the use of the copy command (keystrokes “CTRL-C”, mouse drag and drop of entries, etc.). The pasting produces 3 icons, linked to the respective email messages (“Findlaw Daily Opinion...”window showing the display of one of the messages after having clicked on its icon), and textual description of the email messages(page 3).

Regarding claims 2, 9, and 16, the Appellant alleges that the references alone or in combination fail to teach the document summary data pertaining to the document associated with the selected entry and the hyperlink to the document associated with the selected entry are combined so that the user can click on the document summary data itself to activate the hyperlink (page 13, parag.2). The Examiner disagrees, because Huang teaches the display of the selected files along with an email recipient’s information, accessing the email by selecting the hyperlink of file email entry—document summary data-- (0060, and window 320 fig. 3B). In other words, the window displays a list of email messages along with hyperlinked description information. The user displays a given message based upon the selection of the hyperlinked message(s).

Regarding claims 7, 14, and 21, the Appellant submits that none of the references alone or in combination disclose, teach, or suggest creating the reusable list further comprises the step of inserting the document summary data and the hyperlink included in the reusable list into on or more rows of a table, and wherein the table is stored in the system

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clipboard (page 13, parag.2). The Examiner disagrees, because Barnes teaches the copying of information using Windows system clipboard, in a table, which includes one column and several rows (page 60, lines 4-9, 15-19, fig.10.1).

Additionally, the Appellant submit that Huang does not teach a hyperlink to the document associated with the document (page 14). The Examiner disagrees because the list of email messages that is copied and pasted to the wordprocessing application contains a hyperlink to the message itself, so whenever a user clicks on the message description, the message itself with all of its contents is displayed in another window (0060, fig.3B).

Claims 8, 15, and 23-24 are rejected at least based on the rationale above in regards to claim 1.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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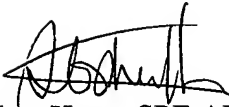
Conclusion

For all of the reasons stated above the Examiner believes that the rejections should be sustained.

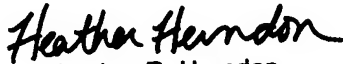
Respectfully submitted,



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